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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/661,919

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William J. Taylor

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EXAMINER

STOKLOSA, JOSEPH A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/661,919	Applicant(s) TAYLOR ET AL.	
	Examiner JOSEPH STOKLOSA	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14, 16-36, 38-48, 50-57, 59-65 and 68-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14, 16-36, 38-48, 50-57, 59-65 and 68-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/26/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/2008 has been entered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1,2, 5, 7-14, 16-22, 25-36, 38-45, 48- 57, and 59-64, are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifried et al. (US 5,531,003) in view of Stevenson et al. (US 6,159,560) and in view of Dahlberg (US 5,245,999).

4. Seifried discloses a feedthrough assembly comprising a ferrule (10) having an inner surface and an outer surface, a terminal (electrical pin lead 12) extending through said ferrule, a conductive refractory metal coating of titanium (Col. 3, lines 1-49), an insulating body formed through an insulating seal (Col. 2, line 15-20). Seifried discloses that the feedthrough assembly is to be used with an implantable pulse generator, which includes an encasement or container having electrical components disposed within the container (Col. 2, lines 1-35). Seifried discloses the ferrule to run into the container of the IPG to make electrical connection to the components disposed within (Col. 2, lines 24-34).

5. Seifried fails to disclose a second conductive coating of a noble metal. Stevenson et al. disclose a process for depositing a silver coating on selected, metallic components of a feedthrough assembly where the first conductive coating serves as an adhesive, to displace surface oxide and provide for greater conductive contact and increased depositing of the second coating. Stevenson teaches to administer the second coating to either the terminal pin **or the ferrule** (ABSTRACT; Col. 4, line 18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried with a second metallic coating of a noble metal, where the first coating serves as an adhesive as taught by Stevenson, since such a modification would provide the predictable results of a second metallic

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coating of a noble metal, where the first metal serving as an adhesive provides for displacement of surface oxidation and providing for greater conductive contact and increased depositing of the second coating. Examiner interprets the welding like action of depositing the second coating on a first metallic coating to sufficiently satisfy the first coating serving as an adhesive. The welding action will melt the first coating and will act as an adhesive in fusing the first coating to the second coating.

6. Seifried et al. and Stevenson et al. fail to specifically disclose a second connector for electrically coupling and mechanically engaging the ferrule outer surface with a second electrical contact coupled to the electrical device. It is well known in the art to utilize a second connector for electrically coupling and mechanically engaging the ferrule outer surface with the pacemaker circuitry in order to enable the pacemaker to operate in an unipolar mode (that is, the housing, which is attached to the ferrule, of the pacemaker is utilized as the ground electrode in electrical stimulation of the heart). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried in view of Stevenson with a second connector for electrically coupling and mechanically engaging the ferrule outer surface with a second electrical contact coupled to the electrical device, since such a modification would provide the system with the predictable results of enabling the pacemaker to operate in an unipolar mode (that is, the housing, which is attached to the ferrule, of the pacemaker is utilized as the ground electrode in electrical stimulation of the heart).

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7. Dahlberg et al. teaches a feedthrough apparatus for a pacemaker that permits unipolar operation of the pacemaker. The feedthrough (1) includes a case 3 (i.e., a ferrule) which extends through the pacemaker housing (2), wherein the case encloses an insulating compound (4) through which a conductor or terminal pin (5) runs (see, for example, col. 4, lines 20-32). In order to enable a unipolar connection, connecting means 9 electrically and mechanically connects the outer surface of case 3 to an indifferent pole 10 of the stimulating pulse generating circuitry 26 of the pacemaker (see, for example, col. 4, lines 33-66). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the feedthrough assembly of Seifried et al in view of Stevenson et al. such that a second connector electrically and mechanically connects the ferrule outer surface to the circuitry of the pacemaker as taught by Dahlberg et al. since such a modification would provide the predictable results of enabling the pacemaker to function in a unipolar stimulation mode, thereby requiring only one stimulation electrode for pacing the heart.

8. With respect to claims 2 and 45, Seifried et al. discloses that the conductive metal coating (30) also covers an area of said terminal adjacent to said body of insulation material (see Fig. 1).

9. With respect to claims 5, 35, and 48, Seifried et al. discloses that the conductive metal coating entirely covers said terminal (see Fig. 1).

10. With respect to claims 9-11, 25, 28-30, 49, and 52-54, Seifried et al. discloses that the conductive metal coating is a noble metal or a noble metal alloy (see col. 3,

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lines 35-40). Seifried et al. discloses that the conductive metal coating may be gold, platinum, palladium, and titanium (see col. 3, lines 35-40).

11. With respect to claims 7-8, 26-27, and 50-51, Seifried et al. discloses a feedthrough assembly comprising a conductive metal coating covering the terminal said coating being more resistant to oxidation than said terminal (a metallic film or coating 30 is placed on the pin to minimize and control the growth of the oxide thereon; see col. 3, lines 1-25). Seifried discloses that the conductive metal coating may be gold, platinum, palladium, and titanium (see col. 3, lines 35-40), but fails to specifically disclose that the conductive metal coating may be rhodium or ruthenium. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to substitute either rhodium or ruthenium as the conductive metal coating since such a modification would provide the predictable results of minimizing and controlling the growth of oxidation on the terminal would be within the level of ordinary skill in the art.

12. With respect to claims 12-13, 31-32, and 55-56, Seifried et al. discloses that the thickness of the coating is not critical so long as it is substantially continuous in its coverage. It may range from 500A to about 10,000A (see col. 3, lines 20-25).

13. With respect to claims 14, 36, and 57, Seifried et al. discloses that the terminal (pin 12) is a refractory metal or a refractory metal alloy (tantalum or niobium).

16. With respect to claims 16, 38, 59, and 65, Dahlberg et al. fails to disclose that the connector is a spring contact. As admitted by Applicant at page 9, spring devices are well known in the art for ensuring an electrical connection between two structures. It would have been obvious to one having ordinary skill in the art at the time of applicant's

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invention to utilize a spring device as the connector because the selection of any connector in would be within the level or ordinary skill in the art for providing the predictable results of ensuring an electrical connection between the two structures

14. With respect to claims 17, 39, and 60, Stevenson et al. discloses that the second conductive coating is a noble metal (silver).

15. With respect to claims 18-19, 40-41, and 62-63, Stevenson et al. discloses that since the ferrule is often formed of a material susceptible to oxidation, such a coating helps guarantee a long term electrical connection which will remain oxide free (see col. 5, lines 1-7), but fails to specifically disclose that the conductive coating may be titanium or niobium. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to substitute either titanium or niobium as the conductive coating because the selection of any conductive metal would be within the level or ordinary skill in the art for providing the predictable results of establishing a reliable electrical connection which is also resistant to oxidation

16. With respect to claims 20-21, 42-43, and 63-64, Stevenson et al. fails to disclose the specific thickness of the conductive pad attached to the ferrule. However, Seifried et al. discloses that a satisfactory thickness of a conductive coating that is resistant to oxidation may range from 500A to about 10,000A (see col. 3, lines 20-25).

17. With respect to claim 22, Seifried et al. discloses that the feedthrough assembly of Seifried used in an IPG is necessarily manufactured according to the method of claim

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22.

18. With respect to claims 33 and 34, Seifried et al. discloses that the protective metal coating may be applied over the entire pin or it may be applied to only specific portions of the pin (see col. 3, lines 15-20). Seifried et al. fails to specifically disclose that forming the conductive coating includes mechanically or chemically masking areas that are not to be coated with the conductive material (i.e., areas adjacent to the pin or areas on the pin). Masking is a well-known methodology for applying selective coatings (see Stevenson et al. which uses paper mask 44 to shield areas on the feedthrough apparatus which are not to be coated). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to mechanically or chemically mask areas that are not to be coated with the conductive material for providing the predictable results of effectively applying the conductive coating only on the desired area (i.e., avoid coating areas adjacent to the pin or areas on the pin that are not desired to be coated).

19. Claims 3, 23, 46, 68, 70, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifried et al. (US 5,531,003) in view of Stevenson et al. (US 6,159,560) and in view of Dahlberg (US 5,245,999) as applied above and further in view of Pless et al. (US 5,131,388).

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20. Seifried in view of Stevenson and in view of Dahlberg disclose the invention as claimed as applied above, but fail to teach the connection of the feedthrough pin by a mechanical means such as by crimping. Pless teaches that it is known in the medical implant art to crimp the internal electronics of an implantable medical device to provide connection to the feedthrough apparatus as set forth in Col. 4, line 36, for providing an alternative to welding, which is known to be a less complicated connection means as well as less expensive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried in view of Stevenson and in view of Dahlberg, with crimping to provide a connection to the feedthrough apparatus of the internal hybrid electronics since such a modification would provide the predictable results of a system with a less expensive and complicated manner of production.

21. Claims 4, 24, 47, 68, 69, 71, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifried et al. (US 5,531,003) in view of Stevenson et al. (US 6,159,560) and in view of Dahlberg (US 5,245,999) as applied above and further in view of Langer (4,254,775).

22. Seifried in view of Stevenson and in view of Dahlberg disclose the invention as claimed as applied above, but fail to teach the connection of the feedthrough pin by a mechanical means such as by using a spring element.

23. Langer teaches that it is known in the medical implant art that a leaf spring may be used to provide connection of internal hybrid electronics, by forcing hybrid

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electronics to contact through some spring force, to the feedthrough apparatus pin as set forth in Col. 5, line 44-59, for providing the predictable result of ensuring contact between the internal electronics and the pins. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried in view of Stevenson and in view of Dahlberg, with providing connection of the feedthrough pin by a mechanical means such as by using a spring element, since such a modification would provide the system with the predictable result of ensuring contact between the internal electronics and the pins. It is also of note that the claims may be interpreted as reading on any spring connection of the feedthrough apparatus, and not necessarily a spring connection between the internal hybrid electronics and the feedthrough assembly as the claim states that only a connection between the feedthrough assembly and the implantable medical device is created.

24. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried in view of Stevenson and in view of Dahlberg and further in view of Langer with placing the spring contact in direct connection with the ferrule since such a modification would provide the predictable results of providing direct contact to the feedthrough pin, which would require a spring with a smaller spring constant which would inherently reduce the size of the spring, thereby reducing the overall size of the implant. Moreover, it has been held that rearranging of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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25. With regard to claim 65, Seifried in view of Stevenson and in view of Dahlberg disclose the invention as claimed. Seifried discloses applying a first metallic coating to the terminal pin while Stevenson teaches the benefit for applying the coating to the terminal pin **and** the ferrule. It is the Examiner's position that since it would have been obvious to modify the system taught by Seifried (where the terminal pin has a coating applied) by applying the coating to the ferrule and terminal pin as taught by Stevenson, that the silver coating applied as taught by Stevenson would be a second coating on top of the first coating taught by Seifried. In other words by modifying the teaching of Seifried which discloses a coating on the terminal pin, with the teachings of Stevenson, which teach applying a coating ostensibly over both the terminal pin and the ferrule, the previous coating applied by Seifried would in effect become an intermediate coating.

26. In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Seifried with applying a second coating on top of the first coating since such a modification would provide the predictable results of the first coating facilitating adhesion of the second coating, and for preventing oxidation on/in the ferrule.

Response to Arguments

27. Applicant's arguments filed 11/26/2008 have been fully considered but they are not persuasive.

28. Applicant argues that the prior art fails to teach a first coating on the terminal pin, while the second coating is applied on the ferrule. As previously explained above, Seifried discloses applying a coating on the terminal pin, but fails to teach a second

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coating on the ferrule. Stevenson is explicit in teaching a coating on at least the ferrule.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH STOKLOSA whose telephone number is (571)272-1213. The examiner can normally be reached on Monday-Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/
Primary Examiner, Art Unit 3762

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1/27/2009